SUPREME COURT, U. S.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1968

NO. 1005

EARL E. HOWE,

Petitioner,

vs.

GENERAL MOTORS CORPORATION,

Respondent.

BRIEF OF RESPONDENT IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

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Rule 59(d) F.R.C.P. 4

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The petition sets forth no valid reason for granting a writ of certiorari and none exists. The holding sought to be reviewed is not in conflict with the decisions of this Court nor in conflict with any decision in any other circuit. The holding does not involve any unsettled question of federal law or any issue of public importance.

This is a conventional suit for infringement of a patent which expired almost twelve years ago on May 21, 1957. There are no other suits pending on this patent and the filing of any new suit for infringement is barred by the six year statute of limitation (35 U.S.C. 286). Petitioner seeks review of the holding of the Court of Appeals primarily from the evidentiary standpoint rather than on any issue of

law. None of the provisions of Rule 19 of this Court is applicable to the present petition.

The Question Presented

Petitioner has not stated with preciseness and clarity the issue presented to this Court. The actual question involved is whether the Court of Appeals erred when it carefully followed the guidelines established by this Court in *Graham* v. *John Deere,* 383 U.S. 1 (1966), and held on the basis of the findings of fact of the trial court and upon the undisputed disclosures of the prior art patents and publications of record, that the trial court had correctly concluded that the inclined hinge of the Howe patent in suit was obvious at the time of its alleged invention (35 U.S.C. 103).

Petitioner's "threshold question" (Pet. 14-15) is frivolous. It has no legal basis whatsoever and is not before this Court. Judge Perry's comments as to validity on respondent's motion to set aside the order granting a new trial by no stretch of legal reasoning constituted a withdrawal of that issue from the jury nor was it *res judicata.* In the first place, petitioner at the second jury trial had made no earlier motion for a directed verdict or a motion for judgment N.O.V. Petitioner had only moved for a new trial after verdict and entry of judgment. Secondly, Judge Perry's remarks did not constitute a formal ruling, he gave no opinion or reasons therefor and entered no supporting findings or conclusions. Judge Perry, in fact, stated " * * * I believe another judge should take a fresh look at it." (Pet. Book* 27). Moreover, at no time thereafter, either before Judge Robson or in the Court of Appeals, did petitioner make such a contention of *res judicata.* It is raised here for the first time.

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* Refers to booklet filed with the Petition.

Statement Of The Case

The Statement in the petition is incomplete and confusing and contains many unsupported statements, numerous errors and extraneous matters, as does the section entitled "Grounds For Granting The Writ". Accordingly, respondent makes this counter-statement only as to relevant matters and without attempting to correct all the errors in the petition.

Petitioner Howe brought this action against respondent in December 1954, more than fourteen years after he had first notified respondent of infringement and twelve years after petitioner stated he was going to resort to the courts. Petitioner demanded a jury trial.

The equitable defense of laches and estoppel was tried before Judge Walter J. La Buy and on October 17, 1958 Judge La Buy overruled this defense and entered findings of fact and conclusions of law (P.A. 51; 167 F.Supp. 330). The patent issues of validity and infringement were then tried in May, 1960 before Judge La Buy and a jury, the trial resulting in a hung jury. The denial of respondent's motion for a directed verdict by Judge La Buy was without opinion. He rendered no ruling as to patent validity.

Upon reassignment to Judge J. Samuel Perry, the case again came up for trial before a jury from March 20, 1961 to April 7, 1961. The jury brought in a general verdict of "not guilty" in favor of respondent (P.A. 96) and on May 1, 1961 judgment was entered on the verdict dismissing the Complaint and Supplemental Complaint (P.A. 96). On September 20, 1961, more than five months after trial, Judge Perry entered an order on petitioner's motion setting aside the judgment and granting a new trial (P.A. 102).

On October 23, 1961 respondent filed in the United States Court of Appeals for the Seventh Circuit a petition for a writ of mandamus directing Judge Perry to expunge his order granting the new trial and to reinstate the jury verdict. The primary ground of this petition was that Judge Perry in granting the new trial had exceeded his jurisdiction under the doctrine of *Kanatser* v. *Chrysler,* 199 F.2d 610 (C.A. 10, 1952), because the grounds upon which he relied were different from those in petitioner's motion and were initiated by Judge Perry after the expiration of the 10 days' period of Rule 59(d) F.R.C.P. The Court of Appeals denied the petition in *General Motors Corporation* v. *Perry,* 303 F.2d 544 (C.A. 7, 1962), holding that Judge Perry had not exceeded his jurisdiction, but it did not consider patent validity as petitioner here erroneously states (Pet. 15). The Court of Appeals' opinion on the mandamus issue is reproduced in the Appendix to this brief.

Following respondent's motion to dispense with a jury trial, petitioner filed an amended complaint and waived his jury demand (P.A. 17). The trial without a jury was concluded on March 9, 1965 before Judge Edwin A. Robson. After consideration of extensive briefs of the parties, Judge Robson, who was fully aware of the past history of the case and Judge Perry's remarks as to validity, filed a Decision on the Merits (P.A. 708) on April 5, 1966 holding the Howe patent invalid for obviousness under 35 U.S.C. 103. Thereafter, on May 6, 1966 Judge Robson entered findings of fact and conclusions of law supporting that holding (P.A. 739) and entered a final judgment dismissing the complaint (P.A. 742). We reproduce in the Appendix to this brief Judge Robson's findings of fact and conclusions of law which petitioner omitted from his booklet.

Neither Judge Robson nor the Court of Appeals has considered or decided the issue of infringement.

Petitioner appealed from the judgment of invalidity of the patent (P.A. 744), and respondent appealed from Judge La Buy's order dismissing the laches and estoppel defense and also from the order entered by Judge Perry on September 20, 1961 granting the new trial after the second jury trial (P.A. 745). In its opinion affirming Judge Robson's holding of invalidity because of obviousness, the Court of Appeals stated "It is unnecessary to review the issues raised by defendant's appeal" (Pet. Book 67). Hence, the infringement issue, the laches and estoppel defense and the new trial issue are still without final decision by the courts below. However, an affirmance of the trial court's holding of invalidity disposed of the entire controversy between the parties.

Any comments which Judge Picard may have made relative to any alleged inventiveness of the Howe hinge in his opinion in *Howe* v. *Atwood,* 47 F.Supp. 979 (E.D. Mich., 1942) are purely dicta as that was a suit by petitioner on a license agreement. Validity of the Howe patent was not involved. At the time of the 1942 Atwood trial the license had been cancelled. Petitioner has never licensed anyone else nor has he manufactured the hinge of his patent. Commercial success cannot be claimed for the Howe hinge. The hinges supplied by Atwood to Studebaker, Chrysler and Nash and held by Judge Picard to be covered by the Howe patent claims, were identical to respondent's 1939 B.O.P. front door hinging developed by respondent long prior to petitioner's alleged date of invention. The 1939 B.O.P. defense was not ruled upon by the trial court or the Court of Appeals as the prior art patents and publications clearly demonstrated invalidity.

ARGUMENT

Alleged Errors Of Other Courts In Other Cases Can Be No Ground For Granting A Writ In The Case At Bar

It cannot be a ground for granting a writ in the present case that some reviewing courts (not identified) in other cases deliberately have disregarded this Court's guidelines in *Graham* and *U.S.* v. *Adams,* 383 U.S. 39, and that other courts (not indentified) in other cases have also disregarded them although giving lipservice, as petitioner suggests (Pet. 11). Nor can it be a ground for granting the writ in this case that "most" of the courts "are still confused and perplexed" by the fourteen questions posed by the petitioner (Pet. 11, 12) without any showing that they are involved in the case at bar. Assuming, arguendo, that some courts have been in error in their decisions as petitioner suggests, that can be of no consequence as far as the present case is concerned. The present case must be determined on its own merits and the correctness of the Court of Appeals' decision herein must be considered on the basis of the present record and not by what other courts may or may not have done.

The Court of Appeals And The Trial Court Carefully Applied Graham v. John Deere In The Instant Case

Petitioner asserts that the trial court and the Court of Appeals misapplied this Court's decision in *Graham* v. *John Deere Co.,* 383 U.S. 1 (1966). This assertion is disproved by the very opinions of the Court of Appeals (Pet. Book 58-68) and the trial court (Pet. Book 28-57) and by the trial court's findings of fact (Appendix to this brief).

In its opinion, the Court of Appeals expressly referred to the *Graham* v. *John Deere Co.* decision and to the analytical steps prescribed in that decision for resolution of the obviousness issue, and then proceeded to follow faithfully those analytical steps in reaching the same conclusion of obviousness as did the trial court. As indicated by the side headings in its opinion, the Court of Appeals first analyzed the alleged problems to which petitioner Howe had addressed himself in the patent and then reviewed petitioner's solution as stated in the patent claims. Then the Court of Appeals went on to inquire into and determine the scope and content of the prior art (Pet. Book 63-65), the differences between the prior art and the patent claims (Pet. Book 65-66) and the level of ordinary skill in the pertinent art (Pet. Book 67). Having followed and determined those required analytical steps, the Court of Appeals correctly concluded that "the subject matter would have been obvious to a person having ordinary skill in the art." Manifestly, the Court of Appeals adhered strictly to the dictates of *Graham* v. *John Deere Co.* and carefully applied the *Graham* guidelines to the instant case.

The trial court was also fully cognizant of this Court's ruling in *Graham* v. *John Deere.* That controlling case is expressly referred to in the trial court's Conclusion (Pet. Book 54) and the analytical steps are quoted verbatim. While, as stated by the Court of Appeals, the analytical steps may not have been "as meticulously set forth as is desirable," nevertheless the trial court's decision (Pet. Book 28-57) does cover precisely the same ground. After discussing the patent in suit, the trial court carefully analyzed the prior art and its applicability to petitioner's claimed invention (Pet. Book 33-54) and then concluded that the patented invention would have been obvious to a man skilled in the art. The Court of Appeals was fully

satisfied that the trial court had followed the *Graham* v. *John Deere* guidelines when it ruled:

> "We are satisfied, however, that the court did apply the correct tests and reached the proper result." (Pet. Book 59)

Nor is it of any consequence that the Court of Appeals and the trial court did not mention *U.S.* v. *Adams,* 383 U.S. 39, in their decisions as petitioner argues, because the same analytical steps and the same basic rule of law on obviousness were applied in *Graham* and *Adams.* In *U.S.* v. *Adams,* this Court said (p. 41):

> "While this case is controlled on the merits by No. 11, Graham, ante, * * *"

Significantly, petitioner made no reference to *U.S.* v. *Adams* in any of his briefs or petition for rehearing in the Court of Appeals.

As will become self-evident hereinafter, petitioner's further contention that the factual pattern of the case at bar "resembles very closely" the *U.S.* v. *Adams* case is entirely groundless. In *Adams,* the patented battery was held valid as nonobvious because noted experts had expressed disbelief in it, the operating characteristics and results had been shown to have been unexpected and to have far surpassed the then-existing wet batteries (p. 51-52). The factual situation in the case at bar, in view of the prior art which was carefully reviewed by the trial court and by the Court of Appeals, is a far cry from *Adams* and it is no wonder the courts below made no reference to it. *Graham* controlled.

The weakness of petitioner's case is indicated not only by complete agreement by the trial court and the Court of Appeals that the patent was invalid under 35 U.S.C. 103

and the *Graham* decision, but also by the fact that petitioner was unable to secure a favorable verdict from the jury against this respondent in both jury trials. Petitioner thus has failed on the merits in three district court trials and before the Court of Appeals.

The Howe Patent In Suit (P.A. 747)

The Howe patent discloses a single concealed gooseneck hinge for supporting a door in an automobile body with the hinge pin axis inclined to the vertical in such a manner that the door swings in a substantially horizontal arc when it is opened and closed. The patent states that where the side wall of an automobile is inclined or curved inwardly in a transverse view (Fig. 2), such body inclination causes the concealed hinge mounted therein to have its hinge pin axis also inclined inwardly. This inward inclination causes the door to rise too much as it is swung from closed to open position. Excessive door rise is said to be undesirable from the standpoint of appearance and because the door might close rapidly and injure a person's foot or ankle.

The Howe patent then states the solution of this alleged problem, at page 2, column 1, lines 41 to 50, (P.A. 749) to be as follows:

> "As may be seen in Fig. 2 the axis A of the hinge pintle is inclined to the vertical, it being disposed whereby it extends inwardly of the vehicle body as it extends upwardly. As viewed in Fig. 1, the axis A is inclined forwardly as it extends upwardly, whereas the plate portion 6, to which the door is attached is substantially vertical. *The result of this compound angularity of the axis A is that the door 2 when swung about the axis A travels in a substantially horizontal arc.*"*

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* Emphasis added.

Thus, the basic concept of the Howe patent is the use of one angle of inclination to compensate for another angle of inclination of the axis of a concealed hinge so as to cause the door to swing substantially horizontally.

The Prior Art

The Court of Appeals correctly stated (Pet. Book 63) that, as shown by respondent's 1917 Chevrolet (P.A. 122-3) and 1924 Oakland automobiles (D.A. III 2130-38), by the Richard, Soss and Mouche patents (P.A. 803, 811, 758; P.A. 155-158, 187-8) and by the Feldwabel publication (P.A. 703; P.A. 157, 187-8), it was old to use concealed, gooseneck, U-shaped hinges in automobiles prior to Howe. It was further noted by the Court of Appeals that the Mouche patent and the Feldwabel publication further disclose tumble-out bodies of open touring cars wherein the concealed hinges are mounted on an axis which is inclined outwardly of the body and also inclined rearwardly, the rearward inclination thus compensating for the outward inclination so as to cause the door to swing in a substantially horizontal arc. Mouche and Feldwabel thus accomplished the same result sought by petitioner, namely, horizontal door swing.

Petitioner has already conceded that Mouche and Feldwabel with an outward inclination of the hinge axis had the same "problem" and the same solution as petitioner and his present arguments that there was an unsolved problem are baseless. At the second jury trial, petitioner testified (D.A. I 733):

> "Q. Now, is the problem of compensating for outward inclination any different than it is for compensating for inward inclination of the axis?
>
> A. You have got a problem the same way, two angles.

Q. It is the same problem, isn't it?

A. Yes.

Q. For solving both inward inclination and outward inclination?

A. Yes, it is.

Q. And the same solution, except in the one case you incline the axis forwardly toward the front of the car and in the other case you inclined it rearwardly toward the back of the car to compensate?

A. To compensate for it, yes."

At the later trial without a jury, the trial court was made aware of this testimony of petitioner (P.A. 358).

In a futile attempt to overcome Mouche and Feldwabel petitioner argues, in spite of his concessions at trial, that his patented invention (Pet. 4, 6, 22-3, 25-6) does not pertain to open touring cars or roadsters having light weight narrow doors (old fashioned cars) but only to closed cars having steel bodies and larger and heavier doors with glass (modern cars). While the Howe patent does show a closed car in the drawings, no point is made of that. Nowhere in the description or the file wrapper does it state that the invention is limited to closed cars or to larger, heavier doors with glass or that the invention has no application to smaller, lighter doors of open cars. Moreover, the patent claims themselves are unlimited in their terminology, each broadly calling for "a door" and "an automobile body" without regard to size, weight or type of door or body. Defendant's accused convertibles when the windows are down are, in effect, open cars.

Petitioner also argues (Pet. 25), without any basis whatsoever, that his invention is applicable only to tumble-in bodies wherein the hinge axis is inwardly inclined (modern

cars) and is not applicable to tumble-out bodies of open cars where the hinge axis is outwardly inclined (old fashioned cars). Yet, nowhere in the patent or the file wrapper does petitioner say that his invention is to be so limited. Even the claims are not limited to a tumble-in body but broadly call for "an automobile body having an inclined wall" (Claims 1 and 2), "a curved automobile door pillar" (Claim 3), or "an automobile body curved in transverse section" (Claim 4). The claims are not limited to an inward inclination of the hinge axis in a tumble-in body. Their language is so broad as to cover an outward inclination of the hinge axis in a tumble-out body and this broad language accounts for the Court of Appeals' statement:

> "It is perhaps possible to say that the Howe patent claims were anticipated* by the tumble-out prior art." (Pet. Book 67)

Petitioner's attempts to distinguish from Mouche and Feldwabel in the foregoing manner are pure afterthoughts. In *Graham* v. *John Deere,* this Court stated:

> "Graham did not urge before the Patent Office the greater 'flexing' qualities of the '798 patent arrangement which he so heavily relied on in the courts." (P. 23)
>
> • • •
>
> "Petitioners' argument basing validity on the free-flex theory raised for the first time on appeal is reminiscent of *Lincoln Engineering Co.* v. *Stewart-Warner Corp.,* 303 U.S. 545 (1938), where the Court called such an effort 'an afterthought. No such function . . . is

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* In its appeal brief, respondent by means of colored claim charts had demonstrated to the Court of Appeals precisely how the Howe claims were directly anticipated by reading as to all elements on prior art Mouche, Feldwabel, Carr and the 1939 B.O.P. hinge.

hinted at in the specifications of the patent. If this were so vital an element in the functioning of the apparatus it is strange that all mention of it was omitted.' At p. 550. No 'flexing' argument was raised in the Patent Office. Indeed, the trial judge specifically found that 'flexing is not a claim of the patent in suit . . . ' and would not permit interrogation as to flexing in the accused devices." (P. 25)

The pertinency of the Mouche and Feldwabel disclosures is fully supported by findings of fact 4 and 5 of the trial court:

"4. The technique of hinging of doors to the bodies of touring cars, convertibles and closed cars or sedans is the same because the hinging of a car door and its hinge axis is dependent upon the contour of the door and body surface below the belt line. The size and weight of the doors and the use of glass above the belt line do not affect the hinge axis. Howe did not urge before the Patent Office that the technique of hinging doors on closed cars was different from that of hinging doors on open touring cars which he so heavily relied upon at the trial. (P.A. 739)

"5. The problem of compensating for an inward inclination of the hinge axis in the transverse view in a tumble-in body to achieve a substantially horizontal door swing is the inverse of the problem of compensating for an outward inclination of the hinge axis in the transverse view in a tumble-out body and the solution of the problem is the same in each instance. Where there is an outward inclination of the hinge axis, the hinge axis is inclined rearwardly to compensate for it and achieve a substantially horizontal door swing. Where there is an inward inclination of the hinge axis, the hinge axis is then inclined forwardly to compensate for the inward inclination and this also causes the door to swing in a substantially horizontal arc." (P.A. 739-40)

In its discussion of the differences between the prior art and the claims (Pet. Book 65-66), the Court of Appeals took particular note of the above findings of the trial court. However, the Petition wholly ignores these findings of fact.

Further evidence that the trial court was influenced by and carefully followed the *Graham* decision is shown by its opinion (P.A. 736) wherein it stated:

> "It is apparent, however, under the *Graham* decision, supra, that a mere reversal of the inclination of the axis of the prior art on tumble-out auto bodies would be deemed an obvious change, not arising to the dignity of invention. Similarly, the utilization of the old goose-neck type hinge with a variation in arm length adapted to the change in inclination of the axis would also be a manifestation of mechanical skill.
>
> "It should have been clear to a skilled worker in the field that if the axis of a hinge on an outwardly inclined car body was outwardly inclined that when the auto body line was changed to curve inwardly, the axis of the hinge would undergo a comparable change. And it would follow that the arms of the gooseneck hinge would also have to be reversed with the longer one on top and the shorter one on the bottom. The Mouche patent and the Feldwabel article showed practically the inverse of plaintiff's conception, on a tumble-out body."

The trial court was quite correct in its factual comparison with *Graham* v. *John Deere,* 383 U.S. 1, 25, where the patented parts were arranged inversely from the prior art. In finding obviousness, the Supreme Court said:

> "Certainly a person having ordinary skill in the prior art, given the fact that the flex in the shank could be utilized more effectively if allowed to run the entire length of the shank, would immediately see that the thing to do was what Graham did, *i.e.,* invert the shank and the hinge plate."

The Carr patent (P.A. 769; P.A. 155, 187-8), also relied upon as prior art by the trial court and the Court of Appeals, illustrates in Figs. 1, 2, 6, 8, and 11-13 of the drawings, a closed car with a tumble-in body having a door with glass hinged at its rear edge. The hinge axis is rearwardly inclined and Carr states that the axis may also be inclined inwardly, thus calling for the very same compensating hinge angles as in the Howe patent.

The Court of Appeals further held (Pet. Book 64-66) that it would also have been obvious to a man skilled in the art to apply the inwardly and forwardly inclined hinge axis taught by the Smith patent (P.A. 751; P.A. 155, 187-8) to the already well-known concealed gooseneck hinges. Although the Smith hinge was different from Howe, nevertheless Smith clearly discloses and emphasizes a tumble-in body with the inward inclination of the hinge axis being compensated for by a forward inclination (just as in Howe) to cause the door to swing in a substantially horizontal arc. Smith expresses the theory of compensating angles and horizontal door swing for inclined hinges as follows:

> "In order that the top and bottom edges of the door shall remain more nearly horizontal or parallel with the ground level when the door is opened, the hinge joint of the upper hinge is offset longitudinally of the vehicle to compensate for this inward inclination of the hinge axis. The hinge axis of the door is, therefore, diagonally inclined, that is, it is inclined both transversely and longitudinally of the vehicle. As a result of this diagonal inclination of the hinge axis, the door, when opened, will, in theory, tend to close until it is turned to the neutral position in the vertical plane of the hinge axis and beyond that it tends to swing to open position." (P.A. 756, Col. 1, lines 36-51)

This statement of Smith is a direct parallel to that above quoted from the Howe patent. By reference to Smith's

broad Claim 14, the Court of Appeals recognized that Smith's teaching of compensating angles for inclined hinges to a man skilled in the art was not limited to any specific type of hinge but applied to all hinges, including concealed gooseneck hinges (Pet. Book 65).

Thus, both the trial court and the Court of Appeals, after reviewing the scope and content of the prior art, the differences of the prior art from the claims and the level of skill in the art, came to the same conclusion that petitioner's alleged invention was obvious.

The "very serious and vexing" hinging problems which petitioner pretends others had failed to solve until he disclosed his patented hinge (Pet. 6-8) are pure fantasy. That the record is devoid of any convincing evidence in this regard was fully recognized by the Court of Appeals when it said:

> "Mr. Howe, of course, emphasizes the fact that no automobile manufacturer, before the time of his patent, produced a closed car with a tumble-in body, with all hinges concealed. This type of fact is referred to by the Supreme Court in *Graham* as relevant, but secondary. It would be more persuasive here if the record had satisfactorily shown that the problem, addressed by Mr. Howe, of accommodating a desirable pattern of door swing to an inclined hinge axis, was really the stumbling block for a substantial period." (Pet. Book 67)

Petitioner's contrary arguments, in effect, request this Court to make an evidentiary review of the record.

In any event there was no existing hinge problem in the automobile industry as suggested by petitioner (P.A. 541-2). The Smith, Carr and Mouche patents and the Feldwabel publication had already taught the solution to

the alleged problem of substantially horizontal door swing with a concealed hinge on an inclined axis prior to Howe and that is true whether the doors were modern sedan doors or old fashioned touring car doors. (P.A. 541-2).

Nor did respondent have any unsolved hinge problems as petitioner suggests. Respondent had long used spaced pairs of concealed gooseneck hinges on inclined axes on open cars where the hinging was all below the belt line as in the Howe patent and the accused hinges. Prior to Howe, respondent had used a pair of concealed spaced gooseneck hinges on an inclined axis to support the rear door of the 1939 B.O.P. closed sedan having glass in the doors. Also prior to Howe, respondent had used a concealed gooseneck hinge on an inwardly and forwardly inclined axis (compensating angles) for supporting the front door of the 1939 B.O.P. closed sedan which was thereby caused to swing in a substantially horizontal arc. Petitioner's contention that he taught respondent how to mount concealed gooseneck hinges on an inclined axis is not supported by the record nor is his contention of confidential disclosure.

At pages 8, 24 and 29-30 of his petition, petitioner attempts to inject the issue of breach of confidential relationship for the first time into this case. Such claim for relief was never set forth in the pleadings nor tried as an issue at any of the trials nor was it raised in the Court of Appeals. It cannot be before this Court.

CONCLUSION

The affirmance by the Seventh Circuit Court of Appeals of the trial court's holding of invalidity of the Howe patent in suit for obviousness under 35 U.S.C. 103 is based upon a well-reasoned and fully supported decision. The Court of Appeals' opinion indicates a thorough knowledge of the record and a careful application of the tests promulgated by this Court in *Graham* v. *John Deere*. No ground exists for granting the petition.

The petition is without merit and must be denied.

Respectfully submitted,

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APPENDIX

ENTERED BY JUDGE EDWIN A. ROBSON

304 IN THE UNITED STATES DISTRICT COURT.
* * (Caption—54-C-1893) * *

FINDINGS OF FACT.

1. The stipulations of fact made by the parties are adopted by the Court as a part of its findings of fact.

2. The facts stated in the Decision on the Merits announced by this Court on April 5, 1966, are also adopted as a part of this Court's findings of fact.

3. Applying the test of clarity of disclosure required of a foreign patent and publication (Borg-Warner *vs.* Mall, 220 F. 2d 803, 805 (C. A. 7)), the disclosures of the Mouche patent and the Feldwabel publication are in sufficiently clear and definite terms that a person having the ordinary skill in the art of automobile door hinging could correctly understand and reproduce and use the hinging constructions shown and described therein.

305 4. The technique of hinging of doors to the bodies of touring cars, convertibles and closed cars or sedans is the same because the hinging of a car door and its hinge axis is dependent upon the contour of the door and body surface below the belt line. The size and weight of the doors and the use of glass above the belt line do not affect the hinge axis. Howe did not urge before the Patent Office that the technique of hinging doors on closed cars was different from that of hinging doors on open touring cars which he so heavily relied upon at the trial.

5. The problem of compensating for an inward inclination of the hinge axis in the transverse view in a tumble-in body to achieve a substantially horizontal door swing is the inverse of the problem of compensating for an outward inclination of the hinge axis in the transverse view in a tumble-out body and the solution of the problem is the same in each instance. Where there is an outward inclina-

tion of the hinge axis, the hinge axis is inclined rearwardly to compensate for it and achieve a substantially horizontal door swing. Where there is an inward inclination of the hinge axis, the hinge axis is then inclined forwardly to compensate for the inward inclination and this also causes the door to swing in a substantially horizontal arc.

306 6. At the time Howe made his alleged invention of the patent in suit the differences between the subject matter sought to be patented and the prior art were such that it would have been obvious to a man having ordinary skill in the art of automobile door hinging;

That if an outwardly inclined or tumble-out automobile body having concealed gooseneck hinges mounted on an outwardly inclined hinge axis with a longer arm at the bottom was changed to an inwardly inclined or tumble-in body, the axis of the hinges would undergo a comparable change or reversal to be inwardly inclined; and it would inevitably follow that the rearward inclination of the hinge axis that compensated for outward inclination to cause a substantially horizontal door swing would also be reversed to a forward inclination in order to compensate for the inward inclination and achieve the same compensating effect, and the differences in length of the hinge arms would also be reversed so that the longer arm would then be at the top instead of at the bottom.

307 Conclusions of Law.

1. Defendant has maintained its burden of proof in establishing the invalidity of the Howe patent No. 2,201,490.

2. Under 35 U. S. C. Section 103, the Court concludes, as a matter of law, that the differences between the subject matter sought to be patented by Howe in patent No. 2,201,490 and the prior art are such that the subject matter as a whole would have been obvious at the time the alleged invention was made to a person having ordinary

skill in the art of automobile door hinging and, therefore, the claims, 1, 2, 3 and 4, of the Howe Patent No. 2,201,490, are invalid.

3. Defendant is entitled to a final judgment dismissing with prejudice the Complaint and Supplemental Complaint, as amended, and awarding costs to defendant, except with respect to the issue of laches and estoppel, previously awarded plaintiff in the order of October 22, 1958.

Edwin A. Robson,
United States District Judge.

May 6, 1966.

der advisement during the course of the trial, for a directed verdict.

Petition denied.

1. Patents ⇐315

Grounds for grant of new trial in patent infringement action, including undue influence on jury because of defendant's presentation of excessive evidence, were included among the grounds asserted in plaintiff's motion for new trial, including confusion of issues by "gross duplication" of pertinent evidence, and were not initiated by judge, so that new trial was properly granted more than ten days after judgment for defendant. Fed.Rules Civ.Proc. rule 59 (d), 28 U.S.C.A.; 28 U.S.C.A. § 1651; U.S.Ct.App. 7th Cir. Rule 19, 28 U.S.C.A.

2. Federal Civil Procedure ⇐2121

Where defendant in patent infringement action had made motion in writing in form of a brief for directed verdict at close of evidence, but where motion had been taken under advisement, and where, subsequent to verdict and judgment for defendant, a new trial had been granted, judge did not abuse his discretion by refusing to grant leave to defendant to file memorandum in support of the motion for directed verdict and by denying the motion.

GENERAL MOTORS CORPORATION, Petitioner,

v.

Honorable Joseph Samuel PERRY, United States District Judge, Respondent.

No. 13540.

United States Court of Appeals Seventh Circuit.

April 23, 1962.

Rehearing Denied June 21, 1962.

Proceeding on petition by defendant having judgment in patent infringement action, for writ of mandamus or writ of certiorari or both following grant of new trial. The Court of Appeals, Kiley, Circuit Judge, held that new trial had properly been granted more than ten days after judgment and that trial judge had not abused his discretion by denying defendant's motion, originally taken un-

George N. Hibben, Chicago, Ill., Arthur Raisch, Detroit, Mich., for petitioner.

Warren C. Horton, Chicago, Ill., for respondent.

Before DUFFY, KNOCH and KILEY, Circuit Judges.

KILEY, Circuit Judge.

This is a petition by General Motors Corporation for a Writ of Mandamus, or for Writ of Certiorari, or Both,[1] arising from Howe v. General Motors Corporation, No. 54C1893, pending in the District Court. A rule to show cause issued from this court[2] and respondent

1. 28 U.S.C. § 1651; 7 Cir.R. 19, 28 U.S.C.

2. 7 Cir.R. 19.

answered, presenting the issues before us.

The Howe suit was filed in December 1954, charging patent infringement.[3] The first trial of eleven days resulted in a jury disagreement in May 1960. In September 1960 General Motors' motion for directed verdict in that trial was denied. The case was reassigned to respondent and the second trial, pertinent here, began in March 1961 and lasted three weeks. At the close of the evidence, General Motors' motion for directed verdict was taken under advisement. The jury's sealed verdict of April 10 found General Motors not guilty, and judgment was entered on the verdict May 1, 1961. Respondent granted plaintiff a new trial September 20, 1961. October 3, he denied General Motors leave to file a memorandum in support of its motion for directed verdict, and denied its motion for judgment in accordance with its motion for directed verdict.

[1] The first question is whether the Certiorari should be granted on the ground that respondent exceeded his jurisdiction by granting a new trial September 20, 1961, more than ten days following judgment, in violation of Fed. R.Civ.P. rule 59(d), 28 U.S.C.A.

General Motors contends that the ground of granting the new trial was initiated by the judge and not asserted in the motion. If this is so, Fed.R.Civ. P. rule 59(d) requires the ruling within ten days of the judgment. Kanatser v. Chrysler Corp., 10 Cir., 199 F.2d 610, 615 (1952) cert. denied, 344 U.S. 921, 73 S.Ct. 388, 97 L.Ed. 710 (1953). Respondent's answer to the rule to show cause is that the new trial was granted on a ground in the motion for new trial. Unless the ground can fairly be said to be in the motion for new trial, the rule in the Kanatser case supports General Motors' contention.[4]

We agree with respondent. In the motion, Ground "2" was directed at the "confusion" of "issues" by presentation of irrelevant evidence, and "gross duplication" of pertinent evidence; Ground "4" asserts that presentation of evidence misled the jury as to the meaning of the patent in suit; Grounds "15" and "16", respectively, claimed error in the admission of evidence of a 1925 Oakland automobile and a 1918 Chevrolet with no notice of defenses concerning the exhibits; and Ground "17" assigned error in admission of "full size door models" made for purposes of the suit.

The pertinent part of the order granting the new trial is, "After a careful review of the record and of the proceedings had at the jury trial of this cause, and having given due consideration also to the complicated nature of the issues and evidentiary material presented to the jury, this court feels constrained to grant plaintiff's motion."

One of the reasons stated by respondent at the trial for his ruling was "* * * I * * * thought that the tremendous amount, tremendous amount, of demonstrative evidence that was presented by the defendant, the innumerable doors that were brought in, the excessive amount of evidence, did unduly influence the jury * * *." We think this reason was not initiated by respondent in violation of Fed.R.Civ.P. rule 59(d), but was presented in the motion for new trial. That is sufficient for our conclusion that respondent did not exceed his jurisdiction by ruling on the motion more than ten days after judgment. Cooper v. Midwest Feed Products Co., 8 Cir., 271 F.2d 177, 179 (1959). The petition for Writ of Certiorari seeking to expunge the new trial ordered and to reinstate the judgment must be denied.

3. General Motors asserted, among other defenses, laches and estoppel. These two equitable defenses were tried separately and were determined in October 1958 against General Motors. 167 F.Supp. 330.

4. It is only where the court on its own initiative grants a new trial under Fed. R.Civ.P. rule 59(d) that the order "shall" specify the grounds for the ruling.

[2] The next question is whether a Writ of Mandamus should issue on the claim that respondent abused his discretion in concluding that General Motors' motion for directed verdict of April 1961 was moot, and in denying General Motors leave to file a memorandum in support of its September 29, 1961 motion or to grant it a hearing.

General Motors cites Montgomery Ward & Co. v. Duncan, 311 U.S. 243, 61 S.Ct. 189, 85 L.Ed. 147 (1940); Tribble v. Bruin, 4 Cir., 279 F.2d 424 (1960); and Thurber Corp. v. Fairchild Motor Corp., 5 Cir., 269 F.2d 841 (1959) in support of its contention that respondent erred in concluding that the motion for directed verdict was moot because of the verdict in General Motors' favor and the granting of the new trial. We need not consider this contention because although respondent made a statement to that effect September 29, he ruled on the motion October 3, presumably changing his mind as to the mootness.

General Motors' motion for directed verdict, filed originally in April 1961, was in writing, "in form of a brief," twelve pages long, presenting facts, arguments and authorities. The new trial was granted September 20, 1961, after full argument July 29 by both sides on Howe's motion. September 29 General Motors made its motion for judgment in accordance with its motion for directed verdict. October 3, 1961, respondent entered the order denying General Motors leave to file a memorandum in support of its motion and denying the motion.

We see no abuse of discretion in the order of October 3, 1961. There was pending the memorandum filed in April in support of the motion upon which General Motors' motion of September 29 was based. In the absence of a clear showing to the contrary, we presume that respondent considered the original motion and supporting memorandum with its facts, arguments and authorities. He stated that he spent "hours and hours" on the briefs in the case. Fed.R.Civ.P. rule 59(d) did not require that respondent permit the filing of a written memorandum and his decision was within his discretion. And the rule did not require that respondent grant a hearing in the form of oral argument. This request was also addressed to the sound discretion of respondent.

General Motors had the burden of showing in this court a clear right to the Writ, and if respondent exercised judgment on reasons based on what was properly before him, we are not to say that he abused his discretion. Bankers Life & Cas. Co. v. Holland, 346 U.S. 379, 382, 383, 74 S.Ct. 145, 98 L.Ed. 106 (1953); Chemetron Corp. v. Perry, 7 Cir., 295 F.2d 703 (1961). We conclude that respondent made his ruling on grounds in the motion for new trial, that General Motors has not shown a clear right to the Writ of Mandamus prayed, and that the Writ must be denied.

For the reasons given, the petition for Writ of Mandamus or, in the alternative, for Writ of Certiorari, or Both, is denied.

§ 286. Time limitation on damages

Except as otherwise provided by law, no recovery shall be had for any infringement committed more than six years prior to the filing of the complaint or counterclaim for infringement in the action.

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